

REMARKS/ARGUMENTS

This paper is submitted in response to the Office Action having a mailing date of September 12, 2007. Claims 30-35 are new. Claims 21-25 were previously cancelled. Accordingly, Claims 1-20 and 26-35 are currently pending.

The Examiner has rejected Claims 1-3, 10, and 12-15 as being anticipated under 35 U.S.C. § 102 (b) by U.S. Patent No. 2,825,329 to Caesar. Claims 4-9 and 16-19 stand rejected under 35 U.S.C. §103 (a) as being obvious in view of Caesar. Additionally, Claims 11, 20 and 26-29 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over U.S. Patent No. 5,487,741 to Maruyama et al. in view of Caesar. At set forth herein, reconsideration and withdrawal of the rejections are respectfully requested.

The claimed invention is directed to a device for stabilizing an image tracker in a patient's bone during surgery. The device includes a body having an attachment point, which is operable to connect or attach the image tracker to the body. In accordance with embodiments of the invention, the attachment point may include a mounting post, which is operable to releaseably attach the image tracker to the body. This aspect of the claimed invention is recited in Claims 26 and 28, as well as in Claims 1 and 12, as amended. Moreover, new Claims 34 and 35 which are directed to this aspect of the present invention have been added. (Support for Claim 34 can be found in the figures and page 7 of the specification.) It is respectfully submitted that an attachment point or mounting post operable to releaseably attach an image tracker is not disclosed or suggested by the cited prior art. For at least this reason, it is believed that Independent Claims 1, 12, 26 and 28 are allowable over the cited prior art. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 102 (b) of Independent Claims 1 and 12, and the rejections under 35 U.S.C. §103 (a) of Independent Claims 26 and 28 are respectfully requested.

In the Office Action, the Examiner has stated that a "securing mechanism" is not necessarily a single screw and that two screws can be characterized as a securing mechanism. In that regard, Claims 10, 26 and 28 are amended to recite only one bone screw, or a single bone

Amendment and Response to 9/12/2007 Office Action
Application No. 10/624,234

screw, which is inserted through both the first aperture and the second aperture. For this additional reason, it is believed that Claims 10, 26 and 28 are allowable over the cited prior art.

Regrading Independent Claims 12, 26 and 28, it is respectfully noted to the Examiner's attention that these claims recite a passageway between an entrance and an exit aperture, and that the recited bone screw or means for attaching is inserted into the entrance aperture, through the passageway, and out through the exit aperture. It is respectfully submitted that these limitations of Independent Claims 12, 26 and 28 cannot be found in the cited prior art. For this additional reason, it is believed that Independent Claims 12, 26 and 28 are allowable over the cited prior art.

As Claims 2-11, 13-20, 27 and 29-35 depend from allowable independent claims, it is respectfully submitted that these claims are allowable. In addition, it is noted that at least some of the dependent claims recite aspects of the present invention that cannot be found in the cited prior art. Claim 10, as amended, and new Claims 34 and 35 recite a mounting post which is operable to releaseably attach to an image tracker. As mentioned above, this aspect of the present invention cannot be found in the cited prior art. Additionally, new Claims 30-33 recite a stabilizing pin that is removably attachable to the body, and securable to the body by a set screw associated with the body. (Support for new Claims 30-33 can be found in the specification, at for example, pg. 6 lns. 8-14 and in Fig. 7.) These aspects of the present invention cannot be found in the cited prior art. Accordingly, for these additional reasons it is respectfully submitted that Claims 10 and 30-35 are allowable over the cited prior art.

In conclusion, reconsideration and withdrawal of the rejections of the claims as anticipated by and/or obvious over the cited prior art is respectfully requested. It is well recognized that claims are anticipated if, and only if, each and every element, as set forth in the claim is found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the...claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). See MPEP §2131. To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), the Examiner

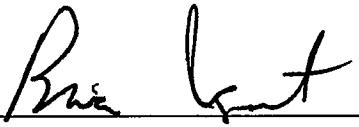
Amendment and Response to 9/12/2007 Office Action
Application No. 10/624,234

must show that 1) the references teach all of the elements of the claimed invention, 2) the references contain some teaching, suggestion or motivation to combine the references, and 3) the references suggest a reasonable expectation of success. See MPEP §2142. See also *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000). As set forth above, Applicant respectfully submits that the cited reference or references do not disclose all of the material elements as required by the rejected claim language.

Based upon the foregoing, the Applicant believes that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

SHERIDAN ROSS P.C.

By: 

Brain J. Ignat
Registration No. 57,174
1560 Broadway, Suite 1200
Denver, Colorado 80202-5141
(303) 863-9700

Date: 12/12/2007